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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,076	12/11/2003	Wade Lee Bowles	71743 CCD	1287

7590 09/21/2005
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EXAMINER

LIN, ING HOUR

ART UNIT PAPER NUMBER

1725

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/735,076	Applicant(s) BOWLES ET AL.	
	Examiner Ing-Hour Lin	Art Unit 1725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-32 is/are allowed.
- 6) ☒ Claim(s) 1-14 and 33-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
3. Claims 1-4, 7, 9-10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/00352 in view of Yanagimoto et al.

WO '352 (page 2, lines 1+) teaches the claimed mold and method for horizontally casting a molten metal, comprising a mold 3, including inlet end 4 and openings 25, 26 provided by a refractory transition plate 19 in a (connecting ring) 5, a preferably circular cavity 17 with an annular outwardly tapered shoulder and a wall 12, 13 or permeable material for supplying oil and gas from a second and a third conduits (separate channels) 10, 11, annuli 20, arranged between the permeable wall material and the mold housing 8, and divided into sections; and cooling slit or nozzles 16 arranged along the circumference of the cavity for direct supply of coolant.

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WO '352 fails to teach the use of a first gas conduit positioned at the corner of the shoulder and cavity wall.

However, Yanagimoto et al (col. 4, lines 66+) teach the claimed first gas conduit 25a at the corner of the shoulder and cavity wall for the purpose of feeding gas into the mold and generating a metal free pocket (space) 26. The gas in this space 26 applies pressure to the molten metal, the contact point of which metal with the mold 21 is then displaced to a down stream position. The gas contains reactive oxygen of 1-15% by volume and other part of argon. It would have been obvious to one having ordinary skill in the art to provide WO '352 the use of a first gas conduit positioned at the corner of the shoulder and cavity wall as taught by Yanagimoto et al in order to effectively cast metal having protective oxide film without sticking the mold surfaces.

4. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/00352 in view of Yanagimoto et al and further in view of Thoenton.

WO 01/00352 in view of Yanagimoto et al fails to teach the use of impermeable barrier.

However, Thoenton (col. 3, lines 13+) teaches the claimed impermeable barrier 23 formed from a flexible graphite material for the purpose of preventing oxide formed the casting wall and directing gas moving towards the bores 27. It would have been obvious to one having ordinary skill in the art to provide WO '352 in view of Yanagimoto et al the use of impermeable barrier as taught by Thoenton in order to effectively of direct gas or lubricant oil and prevent oxide formed the casting wall.

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5. Claims 8 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/00352 in view of Yanagimoto et al and further in view of Kudo et al and McGee et al.

WO 01/00352 in view of Yanagimoto et al fails to teach the use of detectors to measure the electric resistance variation between the mold cavity wall and molten metal.

However, Kubo et al (col. 2, lines 66+) teach the use of detectors (sensor) S for the purpose of directly measuring the variation of resistance and detecting gas oil (col. 2, lines 8). McGee et al teach the use of detectors (sensor) 224 having electrodes 214 216 for the purpose of measuring the variation of resistance corresponding to the metal content in the lubricant oil. It would have been obvious to one having ordinary skill in the art to provide WO '352 in view of Yanagimoto et al the use of detectors (sensor) S and electrodes as taught by Kudo et al and McGee et al in order to of effectively measure the electric resistance variation between the mold cavity wall and molten metal present in the mold during casting.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/00352 in view of Yanagimoto et al and further in view Ohno.

WO 01/00352 in view of Yanagimoto et al fails to teach the use of non-circular inlet opening for the mold.

However, Ohno (col. 2, lines 23+) teaches the use of non-circular inlet opening such as U or C in cross-section for the mold for the purpose of producing an ingot without defects but having a circular cross-section. It would have been obvious to one having ordinary skill in the art to provide WO '352 in view of Yanagimoto et al the use of non-circular inlet opening for the mold as taught by Ohno in order to of effectively produce an ingot without defects but having a circular cross-section.

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7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/00352 in view of Yanagimoto et al and further in view Kittilsen et al.

WO 01/00352 in view of Yanagimoto et al fails to teach the use of asymmetrically arranging the inlet opening to the mold.

However, Kittilsen et al (col. 3, lines 39+) teach the use of asymmetrically arranging the inlet opening to the mold for the purpose of avoiding heat convection to the top surface of the ingot such that the sump exists with its deepest point in the center of the ingot. It would have been obvious to one having ordinary skill in the art to provide WO '352 in view of Yanagimoto et al the use of asymmetrically arranging the inlet opening to mold as taught by Kittilsen et al in order to of effectively avoid heat convection to the top surface of the ingot such that the sump exists with its deepest point in the center of the ingot.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/00352 in view of Yanagimoto et al and further in view of Foye et al.

WO 01/00352 in view of Yanagimoto et al fails to teach the use of controlling the coolant discharge openings around the mold.

However, Foye et al (col. 2, lines 26+) teach the use of controlling the coolant discharge openings around the mold for the purpose of and preventing defects on the cast ingot. It would have been obvious to one having ordinary skill in the art to provide WO '352 in view of Yanagimoto et al the use of controlling the coolant discharge openings around the mold as taught by Foye et al in order to improve surface quality of the cast ingot.

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9. Claims 34-35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Flowers et al.

Flowers et al (col. 1, lines 32+) teach the continuous casting aluminum alloy in the application of disk “fly” within a micron or less of rotating disk surface and minimum micro roughness through the control of cooling rate and yielding fine grain structure with smaller than 1 micron dendritic arm spacing (col. 8, lines 65+) in order to satisfy the application of a disk “fly” within a micron or less of rotating disk surface.

Flowers et al do not teach the use of a roughness of less than 50 microns over at least 50% of the circumferential area. However, the use of a roughness of less than 50 microns over at least 50% of the circumferential area would have been obvious to one having ordinary skill in the art to provide fine surface of the product for the purpose of producing minimum micro roughness (col. 1, lines 46+) on the substrate with excellent surface quality.

Allowable Subject Matter

10. Claims 15-32 are allowed.

Response to Arguments

Applicant's arguments in remarks (see pages 7-9) filed on June 27, 2005 have been fully considered. They are persuasive for the method claims but they are not for the apparatus claims 1-14 and 33 and product claims 34-35 because the prior art of WO '352 provides conduits 10 and

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11 wherein one of them can be appropriately or with exchanged order and used as a gas line in the claimed apparatus. Further, the prior art of Flowers et al anticipates the microstructure of smaller than 1 micron dendritic arm spacing. It is the examiner's position that the cast aluminum alloy of Flowers is identical to or only slightly different than the alloy prepared by the method of the claim(s), because both alloys have the same structural similarities, i.e. the same average inter-dendritic arm spacing of less than 10 microns. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). Flowers et al either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the Flowers et al.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ing-Hour Lin whose telephone number is (571) 272-1180. The examiner can normally be reached on M-F (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

I.H.L.

I.-H. Lin

9-16-05

KEVIN KERNS *KevinKerns 9/19/05*
PRIMARY EXAMINER